

REMARKS

I. Status of Claims

Claims 1-8, 11 are pending in this application. Claims 9, 10, 12 -14 have been cancelled. In the official action of October 6, 2003, the Examiner states that claims 7-9 and 11-14 stand withdrawn. Official Action, p. 4. However, in the restriction requirement of July 17, 2003, the Examiner stated that if Group 1 (claims 1-6) was elected, one method of using compound would be examined (claims 8 and 9) along with one process claim (claims 11, 13, and 14). Official Action of July 17, 2003, p. 3. In response to the restriction requirement, Applicants elected Group 1, and chose as the one method claim and one process claim to be examined, claims 8 and 11 respectively. Applicants were therefore confused by the pending Official Action, which states that "claims 7, 8, 9, 11, 12, 13, and 14 continue withdrawn, at this point." Official Action, p. 4.

In view of the Examiner's own instructions in the original restriction requirement, at least claims 1-6, 8, and 11 should be pending. Applicants also request that claim 7 be examined along with claims 1-6 since claim 7 was amended to remove the additional active ingredient that formed the basis of the restriction.

The Examiner indicated that the restriction was not final. However, in an effort to expedite prosecution, Applicants have cancelled claims 9, 10, and 12 - 14. Applicants respectfully request that claims 1-8, and 11 be examined as indicated in the original restriction requirement.

In regard to the claim for foreign priority, Applicants plan to file a supplemental paper submitting a certified copy of German Priority Application, 199 44 767.5.

II. Information Disclosure Statement

The Examiner indicated on the PTO-1449 that the Derwent Abstracts were "incomplete citations." As the abstracts were provided as the English language equivalents of several of the listed patents and the Examiner has indicated that these patents were considered, Applicants assume that the Abstracts were considered even though the Examiner objects to the citation.

Further, Applicants were confused by the Examiner's statement that the Ph.D. Thesis of S. Taghavi-Moghadam, was "not available as published." What does the Examiner mean by this notation? Regardless, the Examiner indicated that he considered the English language publication in *Tetrahedron Letters*, which Applicants believe provide the relevant parts of the thesis. If this is incorrect, the Applicants respectfully request that the Examiner clarify his objection.

III. Rejections under 35 U.S.C. § 112

It appears that the only rejections are under 35 U.S.C. § 112. The Examiner has rejected the pending claims under § 112 for various reasons described in the Official Action. Applicants respectfully traverse.

While the Applicants disagree that the claims are indefinite, in the interest of advancing prosecution, the claims have been amended to define the invention more clearly. Applicants have attempted to address all of the rejections in the following remarks. If there are any remaining rejections that the Examiner believes were not fully addressed by this response, Applicants respectfully request clarification.

Claims 1 and 2 were rejected under § 112, 2nd paragraph in regard to the use of the term "radical." Applicants have removed this term in order to advance prosecution.

Claims 1 and 2 were also apparently rejected under § 112 because of the use of the term aryl and heteroaryl. The Examiner insisted that it was necessary to separate carbocyclic aryl from heterocyclic aryl. Similarly, the Examiner rejected claim 3 because he claims it would be "improper to confuse the meaning of aryl to include theinyl, furyl and pyridine." Official Action, p. 3. Applicants have amended the claims in order to address these concerns and advance prosecution. The amendments should also address the Examiner's antecedent basis rejection regarding heteroaryl.

Several claims were also rejected for use of the phrase "at least one." The Examiner supports this rejection with the unsubstantiated claim that "[t]his type of "open" language does not meet 35 U.S.C. 112, 1st or 2nd paragraph." Official Action p. 2. Applicants respectfully request that the Examiner provide support for this assertion. There is no legal basis for this rejection. Applicants have, however, amended the claims in order to address the indicated concerns regarding this language in order to advance prosecution.

Claims 1-4 were also rejected under § 112. The Examiner states that the mixtures at the end of claims 1-4 breaks the requirement of claiming one compound at a time. Applicants again are unsure of what the Examiner is referring to and request clarification. Applicants have, however, amended the claims in order to address this concerns and advance prosecution.

Claim 8 has been rejected because it "is not believable on its face, that any one compound could have all of those uses." Applicants respectfully disagree. However, Applicants have amended the claim in order to advance prosecution.

The Examiner continues on pages 4- 10 of the Official Action to further reject claim 1 under § 112 for the use of aryl and heteroaryl. It appears that the Examiner rejected the claim for indefiniteness. Applicants respectfully traverse.

In order to meet the requirements of 35 U.S.C. § 112, second paragraph, the claims of an application must define the patentable subject matter with a reasonable degree of particularity and precision. M.P.E.P. § 2173.02. The Federal Circuit has decided that the definiteness of claim language must be analyzed, not in a vacuum, but in light of the content of the application disclosure, the teachings of the prior art, and the claim interpretation that would be given by one possessing the ordinary level of skill in the pertinent art at the time the invention was made. *Id.* Further, breadth is not indefiniteness under § 112, second paragraph. M.P.E.P. § 2173.04.

Applicants respectfully submit that one of ordinary skill in the art would understand what is meant by the term "heteroaryl" as used in the present application and would therefore understand the metes and bounds of the presently claimed invention. When properly analyzed in light of all the claim language, the content of the specification, and the teachings of the prior art, the term "heteroaryl" clearly defines the subject matter that Applicants consider within the scope of their invention with reasonable particularity and precision. Accordingly, Applicants respectfully submit that this reason for rejection is in error and request that this rejection be withdrawn.

The Examiner also states that the specification does not contain adequate representative exemplification for the breadth claimed. Official Action, p. 6. In *In re Angstadt*, 537 F.2d 498, 190 U.S.P.Q. 214 (C.C.P.A. 1976), the court stressed that not every species encompassed by the claims, even in the unpredictable arts, needs to be disclosed. The relevant inquiry is whether the specification discloses enough to enable one of ordinary skill in the art to practice the invention without undue experimentation. The court noted that some experimentation is often to be expected in unpredictable areas and that if §112 required a disclosure of a test with every species covered by a claim in an unpredictable art, then a prohibitive number of actual experiments would have to be performed, discouraging the filing of patent applications in unpredictable areas.

As the Examiner admits, there is whole body of art, larger than the nucleus claimed here regarding heteroaryl. Thus, one of skill in the art, with access to this body of art, in view of the teachings of the specification, would be able to easily determine which heteroaryls are possible to make within the scope of the invention. In fact, a quick search of the USPTO database indicates that over 6600 issued patents since 1976 contain the term "heteroaryl" in the claims. One may therefore assume that the skilled artisan understands the term and would understand its use in the instant claimed invention. Applicants therefore request that this rejection be withdrawn.


Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: February 4, 2004

By:


Anthony C. Tridico
Reg. No. 45,958